

Remarks

The Final Office Action dated October 27, 2010 maintains the following rejections: claims 1-4 and 24 stand rejected under 35 U.S.C. § 103(a) over Vilppula *et al.* (U.S. Patent Pub. 2002/0019698) in view of Yamamoto *et al.* (U.S. Patent Pub. 2003/0109265) and in further view of Roel-Ng *et al.* (U.S. Patent No. 6,002,936); claims 6-9 stand rejected under 35 U.S.C. § 103(a) over the '698, '265 and '936 references and further in view of Ludwig (U.S. Patent No. 6,256,498); claims 10-11, 13, 15-17 and 22-23 stand rejected under 35 U.S.C. § 103(a) over the '698 reference in view of the '265 reference; claims 18-20 stand rejected under 35 U.S.C. § 103(a) over the '698 and '265 references in view of Yabe *et al.* (U.S. Patent Pub. 2003/0013458); and claim 21 stands rejected under 35 U.S.C. § 103(a) over the '698, '265 and '936 references in view of the '458 reference. In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise.

Applicant appreciates the detailed response to Applicant's previous arguments. Notwithstanding, Applicant maintains the traversals of record.

Applicant respectfully traverses all of the § 103(a) rejections of the claims as improper. Applicant submits that the alleged modification of the primary '698 reference with the teachings of the secondary '265 reference is illogical. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." M.P.E.P. § 2143.01 citing *In re Ratti*, 270 F.2d 810 (CCPA 1959). The principle operation taught by the primary '698 reference relates to a single portable terminal device that provides the relied upon interface and control for use with various applications. The '265 reference is directed toward a cellular communication system in which nearly all of the relied upon functionality is provided by remote servers and positioning centers (*see, e.g.*, Fig. 24 and the instant Office Action, pp. 4-5). The Office Action is relying upon a modification that would move the functions of the single portable terminal to one or more remote servers.

The Office Action's assertions that the proposed modification includes the introduction of a single entity (positional information service server 45) ignores the

teachings of the '265 reference. The positional information service server 45 is configured for use in a mobile communications network. The service includes multiple databases including formation regarding subscribes, billing management, and verification and authorization which have no use for a single mobile positioning device. Further, the server 45 is part of a system that includes at least a mobile device and a measuring center 50. The § 103 rejection evidences the Office Action's failure to consider both the claims and the asserted references "as a whole" contrary to the requirements of M.P.E.P. § 2141.02. Accordingly the § 103 rejections are improper and should be withdrawn.

Applicant further traverses the § 103 rejections for lack of correspondence. With particular regards to claim 1 and as applied to its dependent claims, the rejection fails to show correspondence to, in response to detecting a context change, ordering of the list of position determination devices using the context corresponding position determination device selection process and based upon one parameter for each position determination device. None of the cited references teaches such aspects, the alleged combination fails to correspond, and the only evidence of record that suggests such limitations is Applicant's specification.

For instance, Applicant disagrees with the Office Action's assertion that the primary '698 reference teaches ordering a list of devices according to a parameter of each device and in response to a detected context change. The cited portions of the primary '698 reference, instead, appear to teach that newly detected devices (*e.g.*, a car GPS) are simply added or removed from a list of all possible devices. The only time the Office Action has shown that another parameter is used is during a selection process (Fig. 4), which is taught to occur in response to a positioning request. The addition or removal of a device is therefore substantially independent of the determination of which device is "the best possible positioning method for each of the sequence of requests." '698 reference, para. 0053. Accordingly, the conclusion of the Office Action is inconsistent with the teachings of the '698 reference, which have not been shown to order a list of devices, based upon a parameter and in response to detecting a change in context information. Neither of the additionally-cited references have been alleged to or shown to teach correspondences to such aspects.

The Office Action's response to Applicant's arguments appears to misunderstand Applicant's position. The Office Action repeatedly cites to the teaches of the '698 reference, despite the fact that Applicant's arguments are regarding the asserted teachings of the '265 reference. Specifically, Applicant has argued that the '265 reference does not teach ordering in response to context information. As stated above, the '265 reference teaches that the measurement systems are prioritized based on the preferences of the user transmitted with a measurement request. *See, e.g.*, paragraphs 0019, 0169-170, and 0176-177. The ordering disclose in the secondary '265 reference cannot be based on selecting a context-corresponding position determination device selection process for which it is asserted, because the '265 reference does not disclose context information. Instead, in paragraph 0176, for example the server 45 "determines the priority order using the measuring systems in accordance with the measuring quality conditions received from the terminal requesting the measurement." In paragraph 0107 of the '265 reference states that

the "measuring quality conditions" are desires of the party requesting measurement (user) regarding the quality of the measurement of the positional information. The measuring quality conditions are comprised, for example, of information designating the range of time of measuring, information designating the precision of measuring, information designating a condition relating to the rate of billing accompanying measurement, information designating the allowable waiting time up to acquiring the measuring result, etc.

This description includes no mention of context information such as location. Further, the '698 reference does not teach ordering the position methods based on context information. Instead, the cited portions of the '698 reference teach determining the best possible method. There is no indication that the methods are stored in an ordered form based on context information or a selection process as required by the claims. The '698 reference basically skips the step of ordering in response to a change and proceeds to the step of selecting a position determination device when an application requests position information.

In responding to Applicant's previous arguments, the Office Action asserts that the claim fails to recite that the parameters are periodically updated or changed. However, this appears to overlook the claim limitation that, in response to a change in context information, a selection of a selection process occurs, and then the list of position

determining devices is ordered. The ordering occurs independent of a request from an application for position information. For at least these reasons, the § 103 rejections are improper and should be withdrawn.

With particular regards to claim 10 and as applied to its dependent claims, Applicant respectfully submits that the Office Action's assertion that a "register" is a "driver" is not consistent with the plain meaning and the ordinary and customary use of these terms. "[T]he words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification....The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." M.P.E.P. § 2111.01 (citations omitted). Applicant submits that a common use of the term "register" is a hardware device capable of storing small amounts for data. A common use of the term driver, however, is a computer program allowing higher-level computer programs to interact with a hardware device. These uses also appear consistent with both Applicant's specification and the primary '698 reference. The Office Action presents no argument, explanation or evidence that would support deviating from the ordinary and customary use of the terms. Accordingly, Applicant submits that the rejections are improper and requests that they be withdrawn.

Should the Examiner wish to rely on the computer program discussed in paragraphs 27 and 28, such a rejection would constitute new matter. *See, e.g., Hyatt v. Dudas*, 551 F.3d 1307, 1312 (Fed. Cir. 2008) ("a 'ground of rejection' for purposes of Rule 1.192(c)(7) is not merely the statutory requirement for patentability that a claim fails to meet but also the precise reason why the claim fails that requirement."). Should this case go up on appeal, prosecution would have to be reopened to give Applicant sufficient time to respond to such an assertion.

With particular regards to claim 13, Applicant submits that the Office Action does not assert correspondence to the claim limitations. The Office Action only alleges correspondence to one listed parameter (accuracy) rendering the rejection *prima facie* invalid. As the asserted portion of the '698 reference does not appear to include an indication that the data includes either response time or power consumption, the Office

Action has failed to properly assert correspondence. Applicant respectfully requests that the rejection be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Juergen Krause-Polstorff, of NXP Corporation at (408) 474-9062 (or the undersigned).

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